

REMARKS

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's indication that claims 20-24 recite allowable subject matter, and that claims 35, 36 and 38 are allowed.

Amendments

Claim 1 is amended to incorporate the recitations of claims 20-23. As a result of this amendment, claims 19-23 are cancelled. These amendments were previously submitted in the Reply filed February 19, 2004. Claims 39 and 40 are also cancelled.

The above amendments place the application in condition for allowance. In the Advisory Action issued March 18, 2004, the Examiner indicated that claims 1, 2, and 24-28 would be allowed, but that claims 39 and 40 would remain rejected. Thus, by the above amendments, only allowable claims 1, 2 and 24-38 are pending. Entry of the amendments is respectfully requested.

The following remarks correspond to the remarks presented in the previous Reply filed February 19, 2004.

Rejections Under 35 USC §112, first paragraph

Contrary to the assertion in the rejection, applicants' disclosure provides more than adequate support for the concept of the first effluent being essentially devoid of linear and monobranched paraffins. This concept is evident to one of ordinary skill in the art from the discussion in example 1 at pages 12 - 13 and the results presented in Table 3. For the written description requirement, all that is needed is that the disclosures "reasonably convey" that applicants' had possession of the claimed subject matter at the time of filing. See, e.g., *In re Kaslow*, 217 USPQ 1089 (Fed. Cir. 1982). *Ipsis verbis* disclosure is not required. See, e.g., *Fujikawa v. Wattanasin*, 39 USPQ 1895 (Fed. Cir. 1996). In any event, as noted above, claim 40 is amended to delete the language regarding the first effluent being essentially devoid of linear and monobranched paraffins. Instead claim 40 is amended to recite the ratio α as discussed at pages 12-13 and listed in Table 3. Withdrawal of the rejections under 35 USC §112 is respectfully requested.

Rejections under 35 USC §102(b) and §103

Applicants disagree with the Examiner's assessment concerning "consisting essentially of" and the prior art disclosure. The Examiner cites *PPG Industries Inc., v. Guardian Industries Corp.*, 48 USPQ2d 1351 (Fed. Cir. 1998). This case does not hold that an applicant is required to expressly state in the specification what materials are included or excluded by "consisting essentially of" language. The Court held that PPG could have done this, but did not. So, it was left to the jury to decide whether the amount of iron sulfide in the alleged infringing composition affected the basic and novel characteristics of the claimed composition.

As discussed previously, in the process of US '684 two streams are discharged from the isomerization section, the raffinate and the extract. The raffinate 6, as shown in Table 1, contains 37.3% multibranched paraffins and 59% normal and monobranched C5-C7 paraffins. Extract 7 contains, as shown in Table 1, no multibranched paraffins and 88.6% normal and monobranched C5-C7 paraffins.

Thus, both the raffinate and extract contain more than 50% normal and monobranched paraffins. With such an overwhelming proportion of normal and monobranched paraffins, one of ordinary skill in the art would clearly recognize that these streams do not "consist essentially" of multibranched paraffins under any reasonable interpretation of the term. Further, one of ordinary skill in the art would readily recognize that a more than 50% proportion of normal and monobranched paraffins would affect the basic and novel characteristics of a stream consisting essentially of multibranched paraffins. The nature of such streams would exhibit characteristics more like a stream containing only normal and monobranched paraffins, rather than a stream consisting essentially of multibranched paraffins. The rejection presents no evidence to the contrary.

In any event, claim 1 is amended to incorporate the recitation of claims 20-23, which the examiner has already indicated as reciting allowable subject matter. Withdrawal of the rejections under 35 USC §102(b) and §103 is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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